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90196 7590 12/17/2010 John J. Oskorep, Esq. LLC 980 North Michigan Avenue, Suite 1400 One Magnificent Mile Center Chicago, IL 60611				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* M. KHALEDUL ISLAM and ASIF HOSSAIN

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Appeal 2009-008314  
Application 10/693,346  
Technology Center 2600

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Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT, and  
ROBERT E. NAPPI, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 1 through 39.

We reverse.

## INVENTION

The invention is directed to a method of selecting a base station for a mobile device to communicate with. See pages 3 and 4 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

1. In a mobile telephone configured for data communications and operative in accordance with a circuit-switched voice service and a packet data service, a method of selecting a cellular base station transceiver system for communication with the mobile telephone comprising the acts of:

- scanning, via a cellular radio frequency (RF) transceiver, to identify a plurality of cellular base station transceiver systems available for communication including first and second cellular base station: transceiver systems;

- measuring, from the scanning, a first energy-to-interference ratio  $E_c/I_o$  of the first cellular base station transceiver system;

- measuring, from the scanning, a second energy-to-interference ratio  $E_c/I_o$  of the second cellular base station: transceiver system;

- identifying, at the mobile telephone, that the first cellular base station transceiver system provides a Third Generation (3G) or greater communication service;

- identifying, at the mobile telephone, that the second cellular base station transceiver system fails to provide the 3G or greater communication service but provides a communication service that is less than the 3G or greater communication service;

- if, as identified at the mobile telephone, the first energy-to-interference ratio  $E_c/I_o$  is greater than a minimum threshold, even if the first energy-to-interference ratio  $E_c/I_o$  is less than the second energy-to-interference ratio  $E_c/I_o$ ;

- causing the first cellular base station transceiver system to be selected for communication: over the second cellular base station transceiver system

based at least in part on identifying that the first cellular base station transceiver system provides the 3G or greater communication service and the second cellular base station transceiver system fails to provide the 3G or greater communication service.

#### REFERENCES

Kingdon	US 6,047,183	Apr. 4, 2000
Soderbacka	US 2003/00114158 A1	Jun. 19, 2003
Pecen	US 2004/0097233 A1	May 20, 2004
Feder	US 2004/0142693 A1	Jul. 22, 2004
Einola	WO 01/22764 A1	Mar. 29, 2001

#### REJECTIONS AT ISSUE

The Examiner has rejected claims 1 through 5, 36, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Einola and Soderbacka. Answer 4 through 8.

The Examiner has rejected claims 6 through 8, 16, 28, 37, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Kingdon and Soderbacka. Answer 8 through 12.

The Examiner has rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Kingdon, Soderbacka, and Einola. Answer 12, 13.

The Examiner has rejected claims 11 through 15, 17, 23 through 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Einola, Pecan, and Soderbacka. Answer 13 through 17.

The Examiner has rejected claims 18 through 22, and 30 through 35, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Feder in view of Kingdon, Pecan, and Soderbacka. Answer 17 through 22.

## ISSUES

Appellants' contentions, on pages 7 through 20 of the Brief, with respect to the rejection of claims 1 through 6, 11 through 17, 23 through 29, 36, and 37<sup>2</sup> under 35 U.S.C. § 103(a) presents us with the issue: did the Examiner err in finding that the combination of the references teaches the claimed step of causing the mobile device to select the first base station, providing third generation or greater communication, if the energy-to-interference ratio is greater than a minimum threshold even if the energy-to-interference ratio is less than that of a second base station that fails to provide third generation or greater communication?<sup>3</sup>

Appellants' contentions, on pages 20 through 25 of the Brief, with respect to the rejection of claims 7 through 10, 18 through 22, 30 through 35, 38, and 39<sup>4</sup> under 35 U.S.C. § 103(a) presents us with the issue: did the Examiner err in finding that the combination of the references teaches sending to a cellular base station a list which excludes an identifier of a

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<sup>2</sup> We note that this grouping of claims includes several rejections; however all of the rejections rely upon the combination of Feder and Soderbacka.

<sup>3</sup> We note that Appellants' arguments present additional issues; however, we do not reach these issues as this issue is dispositive of the appeal for these claims.

<sup>4</sup> We note that this grouping of claims includes several rejections; however, all of the rejections rely upon the combination of Feder and Kingdon.

second base station because the second base station fails to provide third generation or greater service?

## ANALYSIS

*Rejection of claims 1 through 6, 11 through 17, 23 through 29, 36, and 37.*

Appellants' arguments have persuaded us of error in the Examiner's rejection of claims 1 through 6, 11 through 17, 23 through 29, 36, and 37. Independent claims 1, 11, and 23 recite limitations directed to causing the mobile device to select the first base station, providing third generation or greater communication, if the energy-to-interference ratio is greater than a minimum threshold even if the energy-to-interference ratio is less than that of a second base station that fails to provide third generation or greater communication. The Examiner in rejecting these claims relies upon Feder to teach monitoring an energy-to-interference ratio of a third generation network. Answer 24. The Examiner acknowledges that Feder does not teach comparing the energy-to-interference ratio of two networks but reasons that it would be obvious that if there were a legacy network (not third generation) and a third generation or greater network, that one skilled in the art would select the third generation or greater network to obtain better quality of service. Answer 24. We agree with the Examiner that the skilled artisan might modify Feder to also consider base stations which fail to provide the third generation or greater service. However, we do not find that the Examiner has shown that the skilled artisan would measure energy-to-interference ratio associated with such legacy base stations or that preference would be given to connection to a third generation or greater connection

with lower energy-to-interference ratio than the connection which does not have a third generation or higher service. Accordingly, we will not sustain the Examiner's rejections of claims 1 through 6, 11 through 17, 23 through 29, 36, and 37.

*Rejection of claims 18 through 22, and 30 through 35, 38, and 39.*

Appellants' arguments have persuaded us of error in the Examiner's rejection of claims 18 through 22, and 30 through 35, 38, and 39. Independent claims 7, 18, and 30 recite limitations directed to sending to a cellular base station a list which excludes an identifier of a second base station because the second base station fails to provide third generation or greater service. Appellants argue on page 23 of the Brief that Kingdon, the reference the Examiner relies upon to teach this feature, teaches the cell phone providing a list to the base station which excludes cell base station identities based upon signal strength and not based upon any services offered. In response, the Examiner states that Feder teaches preferences and rules for handoff and that in combination it would be obvious to exclude networks from the list based upon services provided. We disagree with the Examiner, as there is insufficient evidence to support the Examiner's finding, and concur with Appellants. The purpose of the list provided to the base station in Kingdon is to determine the best base stations for identifying the position (location) of the mobile device and is not related to types of services provided. Kingdon, col. 1, ll. 7-14 and col. 5, ll. 48-51. Accordingly, we will not sustain the Examiner's rejections of claims 18 through 22, and 30 through 35, 38, and 39.

### CONCLUSION

Appellants have persuaded us of error in the Examiner's decision to reject claims 1 through 39. Thus, we will not sustain the Examiner's rejections of claims 1 through 39 under 35 U.S.C. § 103(a).

### ORDER

The decision of the Examiner to reject claims 1 through 39 is reversed.



Appeal 2009-008314  
Application 10/693,346

REVERSED

ELD

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